

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/9/90 905 11/12/92 FLUG

EXAMINER

MANG, P

ART UNIT

PAPER NUMBER

2327
DATE MAILED:

11/23/93

SHERIDAN, ROSS AND MCINTOSH
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8/20/93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), _____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned: 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice re Patent Drawing, PTO-848.
3. ☐ Notice of Art Cited by Applicant, PTO-1448. 4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474. 6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claim 1-11, 13-15, 17-23, 25-26 are pending in the application.
- Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claim _____ have been cancelled.
3. ☐ Claim _____ are allowed.
4. ☒ Claim 1-11, 13-15, 17-23, 25-26 are rejected.
5. ☐ Claim _____ are objected to.
6. ☐ Claim _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been. ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

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1. Claims 1-11, 13-15, 17-23, and 25-26 are presented for examination.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-11, 13-15, 17-23, and 25-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. In the claims, it is implied that simultaneous edits can be made to the same portion of the file. It is unclear how this is accomplished.
5. The affidavit under 37 C.F.R. § 1.132 filed 8/18/93 is insufficient to overcome the rejection of claims 1-11, 13-15, 17-23, and 25-26 based upon 35 U.S.C. § 103 as set forth in the last Office action because the evidence of commercial success is not convincing.
6. Applicant alleges a commercial success of the invention and has submitted several articles alleging commercial success, applicant has not submitted sufficient evidence for a showing of commercial success of the invention claimed in the present application for patent. "Patentee which asserts commercial success to support its contention of non-obviousness bears burden of proof of establishing nexus between proven success and patented invention, and prima facie case of nexus is established by evidence of commercial success and by demonstrating that commercially

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successful product or method is invention disclosed and claim[ed] in patent" Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 7 U.S.P.Q.2d 1222 (Fed. Cir. 1988).

Applicant has not demonstrated that the commercially successful product described in the cited publications is the "invention disclosed and claim[ed] in patent." "Evidence as to commercial success is probative of non-obviousness only if it is result of inventive features claimed, as opposed to other factors." Lamont v. Berquer, 7 U.S.P.Q.2d 1580 (Bd. Pat. App. & Inter. 1988). The evidence presented by applicant for a showing of commercial success fails to show that the commercial success alleged by applicant is a "result of inventive features claimed, as opposed to other factors."

Prima facie case of nexus between merits of claimed invention and alleged commercial success is made by showing that product is commercially successful and is invention disclosed and claimed in subject application; this showing, in civil litigation, shifts burden of going forward with evidence to adversary, but such shift is inapplicable in ex parte proceedings in Patent and Trademark Office, since patent examiner has no available means for adducing evidence to show that commercial success was due to extraneous factors, and thus in such ex parte proceedings it is necessary for party to show that commercial success was due to merits of claimed invention.

Ex Parte Remark, 15 U.S.P.Q.2d 1498 (Bd. Pat. App. & Inter. 1990). Applicant has not shown that the product that is commercially successful is the "invention disclosed and claimed in subject application" and "that commercial success was due to merits of

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claimed invention" and therefore applicants showing of commercial success is deemed insufficient to overcome the rejections of the claims.

7. Claims 1-11, 13-15, 17-23, and 25-26 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,008,853 to Bly et al. ("Bly") in view of U.S. Patent No. 5,173,854 to Kaufman et al. ("Kaufman").

8. With respect to claim 18, Bly taught the invention substantially as claimed including the method for contemporaneously editing a computer file by a plurality of computers situated at remote locations, said method comprising the steps of : electrically interconnecting a host computer to the others of a plurality of computers; inputting and receiving editing instructions; editing the file; and transferring data corresponding with the file editing instructions from the host to the other computers; wherein said editing and said transferring occur on a substantially real-time basis.

9. Bly taught the electrically interconnecting a host computer to the others of a plurality of computers at col.15, line 16, where Bly teaches that the system "... includes an Ethernet local area network to which a number of user workstations ... are connected." Bly further teaches, at col.15, line 32 that "the collaborative functions of the system could ... be centralized in a single main CPU" implying a host processor arrangement.

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10. Bly taught the inputting and receiving editing instructions; editing the file; and transferring data corresponding with the file editing instructions from the host to he other computers; wherein said editing and said transferring occur on a substantially real-time basis at col.4, line 37-45.

11. Bly did not specifically teach the transmitting of file editing instructions on a real-time basis as in the present claims, but Kaufman, in the same field of endeavor, did (col.4, lines 3-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the real-time transmission of editing commands to the real-time conferencing system of Bly because of the greater utility which would be provided to Bly by adding editing capabilities in addition to the pointing and marking of Bly.

8. With respect to claim 19, Bly did not teach the voice communications means for transmitting audio signals representative of any user's voice to each other, but the use of telephones for transmitting audio signals representative of users' voices to each other was well-known before the time of the invention. It would have been obvious to use a telephone at each computer site discuss the interactive editing taught by Bly because of the added convenience that verbal interaction would allow.

9. With respect to claims 20-22, Bly did not specifically mention that the interconnection means is a non-dedicated digital communications system, that it

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comprises the voice communications means, that the interconnecting means could be a plurality of modems, or that the interconnection means could be an integrated services digital network (ISDN). Bly did, however, taught the use of a distributed system (col.15, lines 15-36), which contemplated the use of analog telephone or data lines, digital telephone (i.e. non-dedicated) or data (e.g. ISDN) lines, as well as modems.

10. With respect to claims 1-11, 13-15, 17, 23, and 25-26, see the discussions set forth hereinabove.

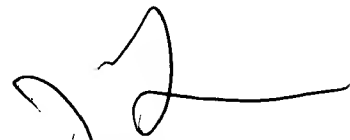
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Y. Wang whose telephone number is (703) 305-3838.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.



Peter Y. Wang

November 19, 1993



THOMAS C. LEE
SUPERVISORY PATENT EXAMINER
GROUP 230